UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/950,087	09/10/2001	P. Hamilton Clark III	D/A1322 (1508/3380)	2257

7590   12/04/2009

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ART UNIT	PAPER NUMBER
3624	

MAIL DATE	DELIVERY MODE
12/04/2009	PAPER

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1   UNITED STATES PATENT AND TRADEMARK OFFICE
2   _____
3
4   BEFORE THE BOARD OF PATENT APPEALS
5   AND INTERFERENCES
6   _____
7
8   *Ex parte* P. HAMILTON CLARK III, JOEL S. CORNELL,
9   KATHY CUPO, WILLIAM KANE, PATRICIA A. LAURIA,
10   JANICE L. MALASZENKO, AUDREY T. PANTAS,
11   AND J. TED POTTER
12   _____
13
14   Appeal 2009-008508
15   Application 09/950,087
16   Technology Center 3600
17   _____
18
19   Decided: December 4, 2009
20   _____
21
22   Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R.
23   MOHANTY, *Administrative Patent Judges.*
24   FETTING, *Administrative Patent Judge.*

25   DECISION ON APPEAL
26

1   STATEMENT OF THE CASE

2   P. Hamilton Clark III, Joel S. Cornell, Kathy Cupo, William Kane,

3 Patricia A. Lauria, Janice L. Malaszenko, Audrey T. Pantas, and J. Ted

4 Potter (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final

5 rejection of claims 1-30, the only claims pending in the application on

6 appeal.

7   We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)

8 (2002).

9   SUMMARY OF DECISION[1]

10   We AFFIRM.

11   THE INVENTION

12   The Appellants invented a way of managing projects using phases

13 (Specification 1:¶ 0001).

14   An understanding of the invention can be derived from a reading of

15 exemplary claim 1, which is reproduced below [bracketed matter and some

16 paragraphing added].

17   1. A method for managing a project, the method comprising:

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[1] Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed January 24, 2007) and Reply Brief ("Reply Br.," filed February 17, 2009), and the Examiner's Answer ("Ans.," mailed December 15, 2008).

1   [1] creating at least one phase for the project;

2   [2] identifying which of one or more stored exit criteria

3   are applicable to at least one of the phases of the project;

4   [3] establishing the identified one or more stored exit criteria
5   for the at least one phase,

6   the one or more exit criteria based at least partially on
7   experience gained from one or more prior projects;

8   [4] determining whether each of the identified one or more
9   stored exit criteria

10   have been satisfied for the at least one phase; and

11   [5] advancing the project to a next one of the phases

12   based on the determination of whether each of the
13   identified one or more stored exit criteria

14   have been satisfied for the at least one phase.

15   THE REJECTIONS

16   The Examiner relies upon the following prior art:

     McAtee   US 5,301,320   Apr. 5, 1994

17   Claims 1-6 and 9-22 stand rejected under 35 U.S.C. § 101 as directed

18   to non-statutory subject matter.

19   Claims 1-5, 7-11, 13-17, 19-21, 23-25, and 27-29 stand rejected under

20   35 U.S.C. § 102(b) as anticipated by McAtee.

21   Claims 6, 12, 18, 22, 26, and 30 stand rejected under 35 U.S.C.

22   § 103(a) as unpatentable over McAtee.

23

1   ARGUMENTS

2   *Claims 1-6 and 9-22 rejected under 35 U.S.C. § 101 as directed to non-*

3   *statutory subject matter.*

4   The Appellants argue that the claims require a device with memory to

5   store the claimed data and so the claims are statutory. Reply Br. 2.

6   *Claims 1-5, 7-11, 13-17, 19-21, 23-25, and 27-29 rejected under 35 U.S.C.*

7   *§ 102(b) as anticipated by McAtee.*

8   The Appellants argue the claims together, and so we treat them as

9   argued as a group. Accordingly, we select claim 1 as representative of the

10   group. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

11   The Appellants contend that McAtee fails to describe identifying which

12   of one or more stored exit criteria are applicable to a project phase. App. Br.

13   8. The Appellants further contend that even if McAtee's tasks are retrieved

14   at some later time to create a program, it is not by way of identifying which

15   of one or more stored exit criteria are applicable. The Appellants also

16   contend that McAtee fails to describe establishing the identified one or more

17   stored exit criteria, because McAtee's designer enters the information. App.

18   Br. 9.

19   *Claims 6, 12, 18, 22, 26, and 30 rejected under 35 U.S.C. § 103(a) as*

20   *unpatentable over McAtee.*

21   These claims further require making the information accessible through

22   a web page. The Examiner found that it would have been obvious to do so

23   because one could then access the data anywhere. Ans. 10. The Appellants

24   rely on their arguments in support of the independent claims for this

1   rejection, and further argue that McAtee fails to show such internet access.

2   App. Br. 11-12.

3   ISSUES

4   The issue of whether the Appellants have sustained their burden of

5   showing that the Examiner erred in rejecting claims 1-6 and 9-22 under

6   35 U.S.C. § 101 as directed to non-statutory subject matter turns on whether

7   the process claims are statutory and whether the system and computer

8   readable media claims are drawn to more than just the process claims.

9   The issue of whether the Appellants have sustained their burden of

10   showing that the Examiner erred in rejecting claims 1-5, 7-11, 13-17, 19-21,

11   23-25, and 27-29 under 35 U.S.C. § 102(b) as anticipated by McAtee turns

12   on whether McAtee describes the limitation [2] of identifying which of one

13   or more stored exit criteria are applicable to at least one of the phases of the

14   project.

15   The issue of whether the Appellants have sustained their burden of

16   showing that the Examiner erred in rejecting claims 6, 12, 18, 22, 26, and 30

17   under 35 U.S.C. § 103(a) as unpatentable over McAtee turns on whether one

18   of ordinary skill would have found it predictable to make McAtee's output

19   accessible over the internet.

20   FACTS PERTINENT TO THE ISSUES

21   The following enumerated Findings of Fact (FF) are believed to be

22   supported by a preponderance of the evidence.

23

24

1   *Facts Related to the Prior Art*

2   *McAtee*

3   01.   McAtee is directed to automated processing of business tasks

4   configured to define, execute, monitor and control the flow of

5   business operations. McAtee 1:8-12.

6   02.   McAtee describes the then existing business environment as an

7   organized sequence of activities whose ultimate purpose, or goal,

8   is to produce a product or provide a service. Each business

9   activity in the sequence involves performance of one or more

10   items of work that bring the business one step closer to

11   completion of the goal. McAtee 1:14-20.

12   03.   Such activities may be strictly ordered with respect to one

13   another, conditionally ordered or completely unordered; they may

14   be automated, partially automated or performed manually; and

15   may be performed using resources within or outside the business.

16   McAtee 1:20-24.

17   04.   Individual work items, termed works in process (WIP),

18   progress through the sequence of activities until they have been

19   transformed into a finished item; that is, until the ultimate goal is

20   achieved. McAtee 1:25-31.

21   05.   With McAtee's system, a designer first defines a workflow by

22   providing the system with a template of business activities that

23   expresses the manner in which these activities relate to one

24   another. Then the system and staff perform the various business

25   tasks that define the work-flow in accordance with the workflow

1   template. The configured system supervises and orchestrates

2   performance of these tasks so that they occur in the specified

3   order. The system represents workflow tasks in a fully modular

4   fashion, so that an identifier for each task, along with a

5   specification of the activities necessary for its completion and the

6   manner in which the task relates to other tasks, are stored as a

7   discrete, self-contained package. McAtee 2:35-57.

8   06.   To configure the system for a particular application, McAtee's

9   designer first defines the workflow by decomposing the business

10   process into an ordered description of discrete goals. Each goal

11   can represent the completion of a business task or activity, or the

12   occurrence of a specific business-related event. McAtee 3:51-57.

13   Before accessing McAtee's workflow system, a designer first

14   breaks down the sequence of business operations into a series of

15   goals, each of which represents a discrete business activity. Each

16   goal is then further decomposed into the tasks necessary for its

17   accomplishment. McAtee 5:25-30.

18 07.   The size of a compound goal (i.e., the number of component

19   goals it specifies) is determined by the designer. If a series of

20   sequential tasks tend to be performed in association with one

21   another, so that in altering the workflow the designer would be

22   likely to shift, as a group, the relationship of these tasks to other

23   tasks, such tasks may be packaged as a single compound goal

24   consisting of multiple primitive goals. If multiple parallel tasks

25   must all be completed before the next goal can become active, the

1   parallel tasks are typically gathered into a single compound goal.

2   McAtee 5:43-54.

3   08.   The designer develops this workflow using an editing facility to

4   generate a database of workflow descriptions that includes goals,

5   relationships among goals and characteristics associated with each

6   goal. These are interpreted and processed to implement and

7   enforce the workflow. The user enters this description

8   information into a data structure for each goal, and the set of data

9   structures for all goals is organized into a table. The fields for

10   each goal can include events that trigger other goals. McAtee

11   5:67 - 6:23.

12   09.   Activities that are assigned to achieve goals are designated as

13   either tasks or events depending on whether they are implemented

14   inside or outside the system. McAtee 6:62-64.

15   *10.   Facts Related To The Level Of Skill In The Art*

16   11.   Neither the Examiner nor the Appellants has addressed the level

17   of ordinary skill in the pertinent arts of systems analysis and

18   programming, project management systems design, and internet

19   publishing. We will therefore consider the cited prior art as

20   representative of the level of ordinary skill in the art. *See Okajima*

21   *v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) ("[T]he

22   absence of specific findings on the level of skill in the art does not

23   give rise to reversible error 'where the prior art itself reflects an

24   appropriate level and a need for testimony is not shown'")

1   (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755

2   F.2d 158, 163 (Fed. Cir. 1985).

3   *Facts Related To Secondary Considerations*

4   12.   There is no evidence on record of secondary considerations of

5   non-obviousness for our consideration.

6   PRINCIPLES OF LAW

7 *Statutory Processes*

8   The law in the area of patent-eligible subject matter for process claims

9 has recently been clarified by the Federal Circuit in *In re Bilski*, 545 F.3d

10 943 (Fed. Cir. 2008) (en banc), *cert. granted*, 77 USLW 3442 (U.S. Jun. 1,

11 2009) (No. 08-964).

12   The en banc court in *Bilski* held that "the machine-or-transformation

13 test, properly applied, is the governing test for determining patent eligibility

14 of a process under § 101." *Id.* at 956. The court in *Bilski* further held that

15 "the 'useful, concrete and tangible result' inquiry is inadequate [to determine

16 whether a claim is patent-eligible under § 101.]" *Id.* at 959-60.

17   The court explained the machine-or-transformation test as follows: "A

18 claimed process is surely patent-eligible under § 101 if: (1) it is tied to a

19 particular machine or apparatus, or (2) it transforms a particular article into a

20 different state or thing." *Id.* at 954 (citations omitted). The court explained

21 that "the use of a specific machine or transformation of an article must

22 impose meaningful limits on the claim's scope to impart patent-eligibility"

23 and "the involvement of the machine or transformation in the claimed

24 process must not merely be insignificant extra-solution activity." *Id.* at 961-

1   62 (citations omitted). As to the transformation branch of the inquiry, the

2   court explained that transformation of a particular article into a different

3   state or thing "must be central to the purpose of the claimed process." *Id.*

4   *Anticipation*

5   "A claim is anticipated only if each and every element as set forth in

6   the claim is found, either expressly or inherently described, in a single prior

7   art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d

8   628, 631 (Fed. Cir. 1987). "When a claim covers several structures or

9   compositions, either generically or as alternatives, the claim is deemed

10   anticipated if any of the structures or compositions within the scope of the

11   claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed.

12   Cir. 2001). "The identical invention must be shown in as complete detail as

13   is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d

14   1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by

15   the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology

16   is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

17   *Obviousness*
18
19   A claimed invention is unpatentable if the differences between it and

20   the prior art are "such that the subject matter as a whole would have been

21   obvious at the time the invention was made to a person having ordinary skill

22   in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 550

23   U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

24   In *Graham*, the Court held that that the obviousness analysis is

25   bottomed on several basic factual inquiries: "[(1)] the scope and content of

26   the prior art are to be determined; [(2)] differences between the prior art and

1   the claims at issue are to be ascertained; and [(3)] the level of ordinary skill

2   in the pertinent art resolved." 383 U.S. at 17. *See also KSR*, 550 U.S. at

3   406. "The combination of familiar elements according to known methods is

4   likely to be obvious when it does no more than yield predictable results." *Id.*

5   at 416.

6   ANALYSIS

7   *Claims 1-6 and 9-22 rejected under 35 U.S.C. § 101 as directed to non-*

8   *statutory subject matter.*

9   We apply the machine-or-transformation test, as described in *Bilski*, to

10 determine whether the subject matter of process claims 1-6 and 9-22 are

11 patent-eligible under 35 U.S.C. § 101.

12   Process claims 1-6 and 9-22 recite a series of process steps that are not

13 tied in any manner to a machine, other than referring to stored data. The

14 claims do not narrow the manner or structural form of such storage. In other

15 words, these claims do not limit the process steps to any specific machine

16 or apparatus. Thus, the claims fail the first prong of the machine-or-

17 transformation test because they are not tied to a particular machine or

18 apparatus.

19   The steps of process claims 1-6 and 9-22 also fail the second prong

20 of the machine-or-transformation test because the data does not represent

21 physical and tangible objects.[2] Rather, the data represents information about

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[2] Because the data does not represent physical and tangible objects, we need not reach the issue of whether mere calculation of a number based on inputs of other numbers is a sufficient "transformation" of data to render a process patent-eligible under § 101.

1   decision criteria, which are intangible attributes. Thus, the process of claims

2   1-6 and 9-22 fails the machine-or-transformation test and is not patent-

3   eligible under 35 U.S.C. § 101.

4   *Claims 1-5, 7-11, 13-17, 19-21, 23-25, and 27-29 rejected under 35 U.S.C.*

5   *§ 102(b) as anticipated by McAtee.*

6   McAtee's system is configured to define, execute, monitor and control

7   the flow of business operations. FF 01. We find that claim 1 is generally

8   drawn to project management (claim 1 preamble), which McAtee describes

9   as part of the then existing business environment. FF 02. McAtee describes

10   as commonplace that project management as a discipline or process orders

11   and executes tasks either manually or by automation until an ultimate goal is

12   achieved. FF 03 - 04. Thus, if limitation [2] recited using exit criteria

13   generally, instead of stored exit criteria, claim 1 would be little more than an

14   explicit recitation of how the tasks in projects such as those described in

15   McAtee's background were carried out.

16   Limitation [2] requires identifying which of one or more stored exit

17   criteria are applicable to at least one of the phases of the project. The

18   Examiner found that McAtee described assigning such exit criteria and

19   storing them in a manner that identified which project phases they applied

20   to. Ans. 6-7 and 10-11. We agree with the Examiner that McAtee describes

21   assigning such exit criteria (FF 05 & 06) and storing them in a manner that

22   identified which project phases they applied to (FF 07).

23   The Appellants contend that in contrast with claim 1, McAtee involves

24   a designer conceptualizing a workflow decomposition and creating a

25   workflow template. App. Br. 8:Last full ¶. It is unclear how the Appellants

1   are attempting to so distinguish the claim from McAtee because nothing

2   in claim 1 would preclude performing the creation, identification, and

3   establishment in steps [1]-[3] by way of creating a template as in McAtee

4   that is later read to direct the flow of steps [4] and [5]. If the Appellants are

5   arguing that steps [1]-[3] are not carried out dynamically during project

6   execution, such an argument is simply not commensurate with the scope of

7   the claims.

8   *Claims 6, 12, 18, 22, 26, and 30 rejected under 35 U.S.C. § 103(a) as*

9   *unpatentable over McAtee.*

10   Here, the sole issue is whether one of ordinary skill would have found

11   it predictable to make information sought accessible through a web page.

12   The Examiner's findings implicitly found it was so predictable. The

13   Appellants do not answer this, but instead merely argues that McAteee fails

14   to describe this, or would change the principle of McAtee's operation. App.

15   Br. 11. The Appellants do not describe just how this would change the

16   principle of McAtee's operation, but we take this argument to be the same as

17   the argument regarding the timing of the identifying step in limitation [2]

18   with claim 1. As with claim 1, such an argument is not commensurate with

19   the scope of the claim. Certainly, simply making information available over

20   the internet would not be incompatible with McAtee, and we agree with the

21   Examiner that the notoriety of using the internet to make information

22   accessible from any computer was well known and practiced by those of

23   ordinary skill. Thus, we find the Appellants' arguments unpersuasive.

1   CONCLUSIONS OF LAW

2   The Appellants have not sustained their burden of showing that the

3   Examiner erred in rejecting claims 1-6 and 9-22 under 35 U.S.C. § 101 as

4   directed to non-statutory subject matter.

5   The Appellants have not sustained their burden of showing that the

6   Examiner erred in rejecting claims 1-5, 7-11, 13-17, 19-21, 23-25, and 27-29

7   under 35 U.S.C. § 102(b) as anticipated by McAtee.

8   The Appellants have not sustained their burden of showing that the

9   Examiner erred in rejecting claims 6, 12, 18, 22, 26, and 30 under 35 U.S.C.

10 § 103(a) as unpatentable over McAtee.

11   DECISION

12   To summarize, our decision is as follows.

13   •   The rejection of claims 1-6 and 9-22 under 35 U.S.C. § 101 as

14   directed to non-statutory subject matter is sustained.

15   •   The rejection of claims 1-5, 7-11, 13-17, 19-21, 23-25, and 27-29

16   under 35 U.S.C. § 102(b) as anticipated by McAtee is sustained.

17   •   The rejection of claims 6, 12, 18, 22, 26, and 30 under 35 U.S.C.

18   § 103(a) as unpatentable over McAtee is sustained.

19   No time period for taking any subsequent action in connection with

20 this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

21   AFFIRMED

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